

REMARKS

Claims 1-41 are now pending in the application. The amendments to the claims contained herein are of equivalent scope as originally filed and, thus, are not a narrowing amendment. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Grainger (U.S. Pat. No. 2002/0161733; "Grainger 1") in view of Grainger (U.S. Pat. No. 2002/0091542; "Grainger 2") and further in view of Fields (U.S. Pat. No. 2002/0069154). This rejection is respectfully traversed.

Grainger 1

Grainger 1 teaches applicability of that invention to include trade mark and copyrights [section 0024]. The examiner submits "*it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Grainger 1 to include this step as normally applicable in the registration of trade mark application*".

The applicant respectfully submits that in view of the teaching of Grainger 1, it would not have been obvious to so modify Grainger 1, because the teaching of Grainger 1 in relation to cost information is restricted to:

Document management;

- 1.
2. Entering information by a customer to record billing information [0050].
- 3.

4. Making available documents necessary for performing a maintenance fee due date reminder [0052]
- 5.
6. The system knows the billing rate for a practitioner [0134] and can therefore calculate a total invoice amount. However, the invoice amount is the calculation of billing rate multiplied by time, and therefore is variable and is not known in advance.

There are only three instances mentioning billing information in Grainger 1, and none of these relate to calculating a cost based on a number of classes of goods/services for a registered trade mark application. There is no disclosure of trade mark classification systems at all in Grainger 1.

Therefore, the applicant respectfully submits that it is not obvious to import registered trade mark classification information into Grainger 1 as being obvious, there being no pointers or specific directions to import that information into the teaching of Grainger 1.

Grainger 1 and Grainger 2

The examiner submits at page 3, paragraph 3 that *"it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Grainger 1 to include this step as taught by Grainger 2. One would have been motivated to do this in order to provide a total cost of registering the trade mark application"*, when discussing the teaching in Grainger 2 of calculating substantially in real time said cost data of said registered trade mark application from stored data (figure 5, section 0011, Grainger 2).

The applicant observes that Grainger 2 at section [0011] mentions only the payment of annuity fees. The discussion at [0047] is also limited to payment of annuity fees, in particular in the case of a patent. In [0049] there is disclosed a "payment history"

which relates to paid annuity/maintenance fees.

Although there is a cost estimator disclosed in Grainger 2, there is no hint or suggestion of any motivation to provide a total costs of registering a trade mark, since this includes filing and prosecution costs. Maintenance fees on a trade mark are only due after registration.

Fields

Fields was first available June 6, 2002, after the filing date of July 19, 2001 of the present application. The inventors were not aware of the Fields' disclosure at the time of the invention and therefore could not have found it obvious to import the teaching of that document into the invention.

Fields talks about classifications, but this is referring to patent classifications, not trade mark classification. At [0014], trade marks are mentioned, and figures 20 to 21 of Fields illustrates a front end for generating a trade mark/service mark base request for proposal (i.e. a quote).

In Figure 20 of Fields, the information collected is minimal and is not enough to generate a detailed quotation/proposal because there is no information concerning the number of classes of goods and services. Since government filing fees are dependent on the number of goods and services, a variation of cost in this manner cannot be avoided. In figure 21 of Fields, the whole issue of fees/costs for classes of goods and services is avoided, since the form states "*all fees are inclusive of government filing fees and disbursements*".

Consequently, Fields avoids the issue of preparing a cost proposal taking into account the classes of goods and services, by avoiding altogether any questions on the classification of goods and services.

Consequently, the system disclosed in Fields is of the prior art type which is one or

two generations behind the present disclosure, and which relies on a restricted costing system which does not allow costing of multi class trade mark applications.

Claims 2 – 10

Claims 2-10 include all of the features of twice-amended Claim 1. Claims 2-10 are novel and non obvious over a combination of Grainger 1, Grainger 2 and Fields for the reasons as set out in respect of twice-amended Claim 1.

Claims 11-13

The examiner submits that *"it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Grainger 1 to include these steps as normally applicable in the registration of trade mark applications"* where *"these steps"* comprise *"reading from said look up table a vendor priority cost data for claiming a priority, a vendor seniority cost for claiming a seniority and a vendor designation cost for designation of a territory; and adding said vendor priority cost data, said vendor seniority cost and vendor designation cost to said vendor filing cost and said official fee filing cost"*.

The applicant respectfully submits that neither Grainger 1, Grainger 2 nor any other of the prior art citations raised in this prosecution deal with the issue of either attorney fees or official fees in relation to priority claims, seniority claims or designation claims. In most instances, these fees cannot be avoided, since government fees for obtaining priority documents or seniority documents are due in addition to corresponding attorney fees, and for designations, official fees depend on the number of territory designations. The applicant submits that it would have not been obvious based on the teaching of Grainger 1 to modify Grainger 1 to include the steps.

Regarding Claim 16

Figure 5 of Grainger 2 discloses filing cost for a patent application in different countries where the different countries are selectable or deselectable.

The extra columns are for different years of maintenance fee.

There is no disclosure of real time variation of any fees in response to changes in classification of goods/services, and no such modification is hinted. The applicant submits it is not obvious to have a real time responsive display which responds to changes in input goods/services for a trade mark application.

Regarding claims 1-41

The examiner combines Grainger 1 and Grainger 2 and Fields ("Modified Grainger") and cites this against multiple claims of the present application. The applicant respectfully submits that even a combination of Grainger 1, Grainger 2 and Fields does not disclose, nor render obvious the combined features of independent claims 1, 14, 29, 30, 36, 38 nor 39. In particular, Modified Grainger does not specifically disclose, calculation of a cost data in real time for a registered trade mark application having multiple classes, where the class information may be modified substantially in real time, and the cost data changes substantially in real time accordingly.

Grainger 1, Grainger 2 and Fields each disclose systems which are one or two generations behind the embodiment of the present application and which would simplify calculations to avoid accommodating multi-class trade mark applications, and which avoid incorporating other component costs such as seniority claim costs, priority claim costs, color claim costs, additional device mark costs and the like.

The applicant respectfully submits that the present amended claims are patentably distinct from Grainger 1, Grainger 2 and Fields either together or in any combination, and similarly for the remaining prior art cited, either taken alone or in combination.

Application in suit

The amended claim 1 is directed to calculation of a real time running total cost of an instruction for a registered trade mark application where the cost changes on entering or

subtracting information relating to data describing at least one territory, and data describing number of classes of goods/services.

Similarly, claim 14 has corresponding amendment as does independent claims 25, 30, 36, 38 and 39.

In Grainger 1, Grainger 2 and Modified Grainger, modification of a real time calculated cost in response to:

1. Variations in territory; and
2. Variations in number of classes of goods or services are not disclosed.

Furthermore, the applicant submits that there is no motivation from the teaching of any of the prior art documents of record to modify Grainger 1 or any other prior art document to include variation of real time calculated cost data in response to data concerning (1) territory, or (2) number of classes of goods or services.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

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Respectfully submitted,

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